

Advisory ActionApplication No.
08/953,477Applicant(s)
Kara, Salim G. et al.Examiner
Joseph PokrzywaGroup Art Unit
2722**THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☒ expires 6 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 15, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☒ Applicant's response has overcome the following rejection(s):
The rejection of claims 57-74, and 90 is overcome in view of the declaration submitted 6/15/00.

- ☒ Newly proposed or amended claims 57-74 and 90 would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: 57-74 and 90Claims objected to: NoneClaims rejected: 31-56, 75-78, 80-89, and 1028

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.
- ☐ Other

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DETAILED ACTION

Advisory Action

1. The period for response continues to run SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Response to Declaration

2. The declaration filed on 6/15/00 under 37 CFR 1.131 is sufficient to overcome the Sundsted (U.S. Patent Number 5,999,967) reference, with respect to claims 57 through 74, and 90.

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Response to Amendment

3. The amendment filed 6/15/00 under 37 CFR 1.116 in response to the final rejection, with respect to **claims 1 through 28, 31 through 56, 75 through 78, and 80 through 89**, has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

4. **Claims 57 through 74, and 90** as proposed, in view of the declaration filed 6/15/00, would be allowable if submitted in a separately filed amendment cancelling all non-allowed claims.

Response to Arguments

5. Applicant's arguments filed 6/15/00, with respect to independent **claims 1, 27, 32, and 75**, have been fully considered but they are not persuasive.

In response to applicants arguments on pages 18 and 19, regarding the rejection of *claim 1*, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Harkins *et al.* (U.S. Patent Number 5,514,126) of the final Office action mailed 3/27/00, stating that Albal teaches away from the claimed invention, therein contradicting Harkins teachings. Albal is unclear if a particular format of the formats utilized in reproduction for delivery are preselected *by an intended recipient of the document*, as stated in the claim, or for that matter, *by the sender of the document*. Albal teaches of a particular format of the formats utilized

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for delivery is **preselected** and stored in a database (column 8, lines 34 through 41, wherein the recipient specific information is chosen and stored, so as to let a communication be sent by a sender merely selecting a recipient name from the database, see column 8, lines 44 through 52).

Albal does not discuss who preselects the delivery formats, if the recipient specific information is from the recipient or from the sender. Because of this Albal does not teach away from the claimed invention. As discussed in the Final rejection dated 3/27/00, Harkins teaches of a particular format of the formats utilized in reproduction for delivery are preselected by an intended recipient of the document (column 8, lines 29 through column 9, line 60). For this reason, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Harkins teachings in Albal's system. Albal's system would become more user friendly if modified to include Harkins teachings, as the transmitted document would take the form most desired by the recipient. Therefore, the rejection of *claim 1*, and all the related dependent claims, as cited in the Final rejection dated 3/27/00, remain rejected as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Harkins *et al.* (U.S. Patent Number 5,514,126).

In response to applicants arguments on page 19, regarding the rejection of *claim 27*, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Cordery *et al.* (U.S. Patent Number 5,454,038) of the final Office action mailed 3/27/00, stating that Cordery teaches that pre-payment is deducted from the electronic funds system stored at the data center, which is separate from the mailer unit (the first location). The examiner restates the particular claim limitation in question, "**said authentication information includes**

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information with respect to pre-payment for transmission of said transmitted document deducted from a credit register stored at said first location". Applicant may be correct in stating that Cordery's data center stores mailer account data and deducts the postage amount from the account upon generation of the PRB. In addition, Cordery does teach of a pre-payment being deducted from a credit register (account data information stored in the storage device 115 in Fig. 1 or 316 in Fig. 3) stored at the first location (see column 6, lines 23 through 52, and column 7, lines 15 through 24, see Fig. 3, and column 7, lines 57 through 59, which states that "postage is transferred from the mailers account to the postal service at the data center electronic funds system 422", wherein if postage is transferred from the mailers account, the mailer's account must deduct a postage amount, and the mailer's account information is located in a memory of the first location). For this reason, the rejection of **claim 27**, and all the related dependent claims, as cited in the Final rejection dated 3/27/00, remain rejected as being unpatentable over Albal in view of Cordery *et al.*

In response to applicants arguments on page 20, regarding the rejection of **claim 27**, stating that there is a lack of motivation for combining Albal and Cordery. As stated in the Final rejection dated 3/27/00, Albal's system would have better security and be more user friendly with addition of Cordery's teachings. Since this is the motivation for combining the references, the rejection of **claim 27**, and all the related dependent claims, as cited in the Final rejection dated 3/27/00, remain rejected as being unpatentable over Albal in view of Cordery *et al.*

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In response to applicants arguments on pages 20, 21, and 23 through 25, regarding the rejection of *claims 32 and 75*, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent number 5,826,034) in view of Maxwell (U.S. Patent Number 5,805,810) of the final Office action mailed 3/27/00, stating that there is a lack of motivation for combining Albal and Maxwell. As stated in the Final rejection dated 3/27/00, Albal's system could easily be modified to include Maxwell's teachings, as the two systems have cumulative features, wherein the motivation lies in the ease of modification of Albal's system, since the systems share cumulative features, being additive in nature. For this reason, the rejection of *claims 32 and 75*, and all the related dependent claims, as cited in the Final rejection dated 3/27/00, remain rejected as being unpatentable over Albal in view of Maxwell.

Allowable Subject Matter

6. **Claims 57 through 74, and 90** are allowed, in view of the declaration dated 6/15/00, which disqualifies Sundsted (U.S. Patent Number 5,999,967) as a prior art reference.

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Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

July 6, 2000


EDWARD L. COLES
SUPERVISORY PATENT EXAMINER
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